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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|-------------------------|-------------------------------|------------------|
| 10/713,502   | 11/15/2003  | Clair John Glossner III | YOR919990548US4<br>(8728-341) | 9966             |
| 46069  | 7590        | 06/06/2006              | EXAMINER<br>PAN, DANIEL H     |                  |
| F. CHAU & ASSOCIATES, LLC<br>130 WOODBURY ROAD<br>WOODBURY, NY 11797 |             |                         | ART UNIT<br>2183              | PAPER NUMBER     |

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/713,502 | <b>Applicant(s)</b><br>GLOSSNER ET AL. |  |
|                              | <b>Examiner</b><br>Daniel Pan        | <b>Art Unit</b><br>2183                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3,5-11,14,16-22,25 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) 4,12,13,15,23,24,26 and 34-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5-11,14,16-22,25 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Clams 3,5-11,14,16-22, 25,27-33 are presented for examination. Claims 4,12,13,15,23,24,26,34-60 have been canceled. Claim 16 is recited as dependent form claim 14. However, examiner believes that claim 16 was meant to be an independent claim. For purpose of examination, claim 16 is being treated as an independent claim. Correction is suggested in the next response. T.D. filed on 04/25/05 has been entered.

2. In view of recent 101 Interim Guidelines training on 01/16/06, the examiner now applying the "101" to the following claims based the reasons given below . Since the last Office action was on 12/05, and since the 101 Interim Guidelines training emphasized a few points not previously taught, the following is a non-final action in order to allow applicant a chance to respond.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 3,5-11,14,16-22, 25,27-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. As to claim 3,7,8,14, 18,19, no physical transformation can be found in the claim. Also, No substantial practical application can be found. Although the computer is being recited in the preamble, no clear structural elements of the computer is being recited in the body of the clam. The vector data file, the pointer array, and the storage

elements are too abstract to construct the computer. Therefore, it is read as field of use. Although the claim also recites the pointer array coupled by a bus, no further limitation of the bus is being recited into the claim, no clear definition of bus is being defined in specification. Therefore, based on a broadest reasonable interpretation, the bus can be in a non-tangible form as well. The vector data file storing the data elements are non-functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In *re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk.

Protection for this type of work is provided under the copyright law. Although claim additionally recites the updating of the data entry by performing of the increment operation on the data entry (see last paragraph of claim), it is directed to feature of step taken to achieve the final result, not the final result itself. The focus is not on the feature of step taken to achieve a final result which is useful, concrete and tangible, but rather the final result achieved is useful, concrete and tangible (see page 20, 101 interim Guidelines published at uspto.gov) . No substantial practical application can be found in the updating of the entries in the vector data file Therefore, the non-statutory subject matter.

5. As to claims 5, 6, 16, 17, additionally recites the increment operation includes a modulo operation and a stride operation. However, no substantial practical application can be found for the modulo operation and stride operation .

6. As to claim 9,10, claim recites the data elements of vector data file were organized in logically in matrix of rows and columns . However, it is directed to non-functional descriptive material, and no substantial practical application can be found in the claim.

7. As to claim 11,20,21,22, claim 11 for example, recites the arbitrary starting address in the vector data file (see claim 11, lines 9-10), however no substantial practical application can be found for the arbitrary starting address. See also analysis regarding non-function descriptive material in paragraph above.

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8. As to claims 25-33, claim 25 additionally recites the program storage device readable by machine, tangibly embodying a program of instructions executable by machine to perform the method in the preamble. However, the claim body only recites the vector data file storing data elements and the plurality of entries, and the updating of the entries. No components or detailed features of the executable instructions in the program storage to impart the functionalities of the machine can be found in the claim to support the preamble. Therefore, the preamble is read as a field of use which does not carry any patentable weight. Furthermore, the program storage device tangibly embodying a program does not necessarily mean that the program storage is tangible itself. Examiner prefers to see stronger language in the claim body to reflect the components of the instructions executable by machine to impart the functionalities of the system. Similar analysis can be done to claims 27-33.

9. The amended claims 3,5, 14,16, 25,27 to combine the dependent features have overcome the rejection under 35 U.S.C. 103(a) based on Watanabe et al. (5,669,013) in view of Karp et al (5,689,653) in view of Pawate et al. (5,528,550). Claims 3,5-11,14,16-22, 25,27-33 are allowable over the art of record upon pending condition of the "101" set forth in this action. Reasons for allowance were given in the prior office action on 12/23/05.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pan whose telephone number is 703 305 9696, or the new number 571 272 4172. The examiner can normally be reached on M-F from 8:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chan, can be reached on 703 305 9712, or the new number 571 272 4162. The fax phone number for the organization where this application or proceeding is assigned is 703 306 5404.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***21 Century Strategic Plan***

DANIEL H. PAN  
PATENT EXAMINER  
GROUP